

Appl. 10/601,828
Reply to Office Action of September 9, 2005
Amendment Dated November 9, 2005

REMARKS

The applicants respond to the pending Office Action as follows. Currently claims 1, 17-19 and 32-53 are pending in the application. Claims 1, 17-19, 32, 36, 40 and 43-50 stand rejected. Claims 33-35, 37-39, 41, 42 and 51-53 have been withdrawn from consideration. The applicants respectfully submit that the foregoing amendments to the specification and claims are fully supported by the application as originally filed and no new matter has been added. Therefore, entry of the foregoing amendments is respectfully requested.

Specification

As shown in the foregoing amendments, the applicants have amended the specification according to the Examiner's suggestions.

Claim Rejections - 35 USC § 112

The Examiner has rejected claims 40, 43-46 and 49 as being indefinite under 35 U.S.C. 112, second paragraph. Accordingly, the applicants have amended claims 40 and 49 and respectfully submit that the claims now comply with Section 112.

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Claim Rejections - 35 USC § 102

The Examiner has rejected claims 1, 18, 19, 40, 45-47 and 49 under 35 U.S.C. 102(b) as being anticipated by Sarka et al., (U.S. Patent No. 3,863,550).

Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference or embodied in a single prior art device or practice. *Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). In addition those elements must either be inherent or disclosed expressly and must be arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). Thus, for anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988). Absence from the reference of any claimed element negates anticipation. *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

The Examiner bases this rejection in part on the assertion that Sarka et al. discloses a "covering/housing/adaptor (e.g., 21, 22)." The applicant refers the Examiner to Column 4, lines 2 – 14 of Sarka et al., which describes the elements referred by numerals 21 and 22 in FIG. 11 as follows:

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The spaced plates, with the posts fixed therebetween are then assembled in a molding fixture (FIG. 11) having a bottom 21 and side walls 22. The steel rules 15 and 16 are coated with mold release and then inserted firmly in the slots 12, and suitable plastic filler material 23 is injected through the holes 13 to fill the space between the plates and imbed the posts 20. The plastic is then cured to provide a semi-rigid laminated structure and the assembled die plate containing the steel rules is removed from the molding frame. The curing may be effected at ambient temperature conditions if desired.

It is clear from this description that elements 21 and 22 are not part of the cutting and scoring die disclosed in the Sarka et al. reference and are clearly not "affixed" thereto. Indeed, elements 21 and 22 form the molding frame which is employed to form the plastic portion of the cutting and scoring die. As indicated therein, "the assembled die plate containing the steel rules is *removed* from the molding frame." (emphasis added). Thus, the molding frame comprised of elements 21 and 22 are not part of the cutting and scoring die and are clearly not "affixed to" as recited in the claims. Accordingly, the applicant respectfully submits that Sarka et al. fails to anticipate the "covering" as recited in claims 1 and 47 and the "housing" as recited in claim 40.

Claim Rejections - 35 USC § 103

The Examiner has rejected claims 17, 32, 36, 43, 44, 48 and 50 under 35 U.S.C. 103(a) as being unpatentable over Sarka et al. (U.S. Patent No. 3,863,550).

The burden is on the Examiner to establish a case of *prima facie* obviousness. *In re Fine* 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The test for establishing such a case is well

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stated in *In re Lintner*, 173 U.S.P.Q. 560, 562 (C.C.P.A. 1972) as follows:

In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teaching would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination or other modification.

An excellent summary of how the prior art must be considered to make a case of *prima facie* obviousness is contained in *In re Ehrreich*, 200 U.S.P.Q. 504, 509-11 (C.C.P.A. 1979). There, the court stated that a reference must not be considered in a vacuum. It is stated that the question of a § 103 case is what the reference(s) would “collectively suggest” to one of ordinary skill in the art. However, the court specifically cautioned that the Examiner must consider the entirety of the disclosure made by the reference.

To establish a *prima facie* case of obviousness with respect to a claimed composition, the prior art must provide some reason or motivation to make the claimed composition, *In re Dillon*, 16 U.S.P.Q.2d 1897, 1901 (Fed. Cir. 1990) (*en banc*). As more recently and aptly stated in *In re Jones*, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (emphasis in original):

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill in the . . . art would have been motivated to make the modifications of the prior art necessary to arrive at the claimed [invention].

With respect to properly considering the prior art, the C.C.P.A. stated in *In re Carroll*, 202 U.S.P.Q. 571, 572 (C.C.P.A. 1979), as follows:

One of the more difficult aspects of resolving questions of non-obviousness is the necessity “to guard against slipping into use of hindsight.” *Graham v. John*

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Deere Co., 383 U.S. 1, 36, 148 USPQ 459, 474 (1965). Many inventions may seem obvious to everyone after they have been made. However, 35 USC 103 instructs us to inquire into whether the claimed invention "would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." Thus, in deciding the issue of obviousness, we must look at the prior art presented from a vantage point in time prior to when the invention was made, and through the eyes of a hypothetical person of ordinary skill in the art.

Again, as previously discussed herein, the applicants respectfully submit that Sarka et al. fails to teach or suggest the "covering" or "housing" as claimed in the pending claims. Indeed, Sarka et al. specifically teaches away from the claimed invention by stating, "steel rules 15 and 16 are coated with mold release," thus further indicating that the mold of Sarka et al. is not a part of the structure of the die and is configured to be released therefrom. Indeed, with the mold of Sarka et al. attached to the die, the die would not function in a manner consistent with the teachings of Sarka et al. That is, there is absolutely no teaching or suggestion in Sarka et al. that the mold is a part of the cutting and scoring die and nothing in the disclosure would suggest to one of skill in the art that the mold should not be removed from the cutting and scoring die before using the cutting and scoring die.

Each of the independent claims state that the "covering" or "housing" of the claimed invention is "affixed." Such a structure is neither taught nor suggested by Sarka et al. and allowance of the claims is respectfully requested.

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CONCLUSION

The Examiner is welcome to call the attorney of record, Frank W. Compagni, at (801) 478-0071 if further discussion of this matter is warranted. Any fees due hereunder may be charged to Deposit Account No. 50-0881.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'Frank W. Compagni', is written over the printed name.

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